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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,492	09/20/2006	Atsushi Tabata	295134US3PCT	1671
22850	7590	10/10/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER LE, DAVID D	
			ART UNIT 3655	PAPER NUMBER
			NOTIFICATION DATE 10/10/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/593,492	<b>Applicant(s)</b> TABATA ET AL.	
	<b>Examiner</b> David D. Le	<b>Art Unit</b> 3655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/20/06, 07/18/08</u> .                                      | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This is the first Office action on the merits of Application No. 10/593,492, filed on 20 September 2006. Claims 15-34 are pending.

### **Documents**

2. The following documents have been received and filed as part of the patent application:
  - Foreign Priority Document, received on 09/20/06
  - Information Disclosure Statement, received on 09/20/06
  - Information Disclosure Statement, received on 07/18/08

### ***Claim Objections***

3. Claim 15 is objected to because of the following informalities:
  - Line 16, "a third ring gear" should be --a second ring gear--.

Appropriate correction is required.

4. Claims 32 and 33 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

*Claim Rejections - 35 USC § 112*

**5. The following is a quotation of the first paragraph of 35 U.S.C. 112:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 15, 16, 20, 25-27 and 30-33 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for embodiment as shown in Fig. 1, does not reasonably provide enablement for a claimed invention as recited in the present claim 15. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Claim 15 specifically requires the first sun gear to be fixed to a stationary member, to be selectively connected through the fourth clutch to the first intermediate output path, to be selectively connected through the third clutch to the second intermediate output path, and to be selectively fixed through the first brake to the stationary member. The present specification does not provide adequate support for these limitations, as recited in claim 15.

7. Claims 17-19, 21-24, 28 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claimed vehicular planetary gear type step-variable transmission, as recited in claims 17-19, 21-24, 28 and 29, appears to require a collinear chart as a physical component of the

claimed transmission. Clearly, as shown in Fig. 1, the disclosed transmission does not include a collinear chart as one of its physical components. Accordingly, the present specification does not appear to adequately provide support for the claimed invention.

**8. The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 15-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 15:**

- Lines 18-20 recite the limitation “said first sun gear being selectively connected through a fourth clutch to said first intermediate output path, selectively connected through a third clutch to said second intermediate output path, and selectively fixed through a first brake to said stationary member”. This claimed limitation appears to be inaccurate because, as shown in Fig. 1, the second sun gear (S2), not the first sun gear (S1), is selectively connected through a fourth clutch (C4) to the first intermediate output path (M1), selectively connected through a third clutch (C3) to the second intermediate output path (M2), and selectively fixed through a first brake (B1) to the stationary member (11).

Claim 17:

- Line 20 recites the limitation “a collinear chart”. It is unclear how the claimed transmission would properly function with a collinear chart as part of its physical components.

Claim 21:

- Lines 2-3 recite the limitations “said fourth clutch piston” and “the friction members”. There is insufficient antecedent basis for these limitations in the claim.

Claim 22:

- Line 2 recites the limitation “said fourth clutch piston”. There is insufficient antecedent basis for this limitation in the claim.

Claim 24:

- Line 3 recites the limitation “said third clutch piston”. There is insufficient antecedent basis for this limitation in the claim.

Claim 27:

- Line 4 recites the limitation “the friction members”. There is insufficient antecedent basis for this limitation in the claim.

Claim 33:

- Lines 6-14 recite the limitation “said first sun gear being selectively connected through said fourth clutch to said first intermediate output path, selectively connected through said third clutch to said second intermediate output path, and selectively fixed through said first brake to said stationary member”. This claimed limitation appears to be inaccurate because, as shown in Fig. 1, the second sun gear (S2), not the first sun gear (S1), is selectively connected through a fourth clutch (C4) to the first intermediate output path (M1), selectively connected through a third clutch (C3) to the second intermediate output path (M2), and selectively fixed through a first brake (B1) to the stationary member (11).

Claim 34:

- Claim 34 is currently dependent upon the cancelled claim 14. Accordingly, the scope of claim 34 is presently not ascertainable.

***Double Patenting***

10. Claims 30 and 31 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 25 and 26, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Morisawa et al. (U. S. Patent No. 5,525,117) teaches a gear transmission, as shown in Fig. 1.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Le whose telephone number is 571-272-7092. The examiner can normally be reached on Mon-Fri (0900-1730).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ddl

/David D. Le/  
Primary Examiner, Art Unit 3655  
09/30/2008



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